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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,485	08/14/2001	Takumi Oishi	ASAM.0018	7901

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EXAMINER
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BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/928,485

Applicant(s)

OISHI ET AL.

Examiner

Alicia Baturay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/928,485.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>05192004</u>  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This Office Action is in response to the amendment filed 22 April 2005.
2. Claims 1-3, 6 and 7 were amended.
3. Claims 4 and 5 were cancelled.
4. Claim 8 was added.
5. Claims 1-3 and 6-8 are pending in this Office Action.

***Response to Amendment***

6. The objection to the specification regarding the title was addressed and is withdrawn.
7. The objection to the drawing was addressed and is withdrawn.
8. The objections to claims 1 and 3 were addressed and are withdrawn.
9. The rejection of claims 1 and 2 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph regarding indefiniteness was addressed and is withdrawn.
10. The rejection of claims 2, 6, and 7 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph regarding lack of antecedent basis was addressed and is withdrawn.
11. Applicant's amendments and arguments with respect to claims 1-3, 6 and 7 and new claim 8 filed on 22 April 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 recites the limitation "said translation information." There is insufficient antecedent basis for this limitation in the claim. It is suggested that Applicant remove the word "said" from the phrase.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millet (U.S. 6,434,627) and further in view of Tsirtsis ("Network Address Translation – Protocol Translation (NAT-PT)").

Millet teaches the invention substantially as claimed including an address translation method that allows a computer network to automatically learn that a visiting node has attached and then automatically establish a virtual gateway so that the visiting node can communicate through the network using address translation (Millet, see Abstract).

16. As to claim 1, Millet teaches a method of translating addresses at a translator connected to a first network for transferring data in a first protocol, to a second network for transferring data in a second protocol, and to a translation server to which other translators are connected, at least one of the other translators being connected to the second network, a third network and the translation server, the method comprising the steps of:

Detecting an address query of a second terminal accommodated in the second network, from a first terminal accommodated in the first network; generating a first address in the first protocol corresponding to a second address in the second protocol which is provided to the second terminal in the second network (Millet, Fig. 7); retaining a correspondence between the first address and the second address as the translation information for a protocol translation between the first protocol and the second protocol (Millet, Fig. 7, element 715; col. 13, lines 30-32); and registering the correspondence between the first address and the second address at the translation server (Millet, col. 11, lines 34-43). The embodiment of the address translation system on a router and several address translation lists being present inherently suggests that there are multiple translators that share their respective translation lists.

Millet does not explicitly teach the use of two differing protocols.

However, Tsirtsis teaches a process of translation of protocols (Tsirtsis, page 4, "Protocol Translation (PT)") for transferring data in a first protocol and for transferring data in a second protocol (Tsirtsis, page 4, "Protocol Translation (PT)").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millet in view of Tsirtsis in order to enable the use of two differing

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protocols. One would be motivated to do so in order to allow transparency protocol translation from the view of the client.

17. As to claim 6, Millet teaches an address translation server connected to a first network and a second network for transferring data in a first protocol, and to a third network for transferring data in a second protocol, and to a terminal which has moved from the first network to the second network, comprising

A memory device (Millet, col. 11, line 56 – col. 12, line 8) for storing a correspondence information among a name of the terminal, and an address of the terminal (Millet, Fig. 7, element 715; col. 13, lines 26-32).

Millet does not explicitly teach the use of two differing protocols.

However, Tsirtsis teaches a process of translation of protocols (Tsirtsis, page 4, “Protocol Translation (PT)”) for transferring data in a first protocol and for transferring data in a second protocol (Tsirtsis, page 4, “Protocol Translation (PT)”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millet in view of Tsirtsis in order to enable the use of two differing protocols. One would be motivated to do so in order to allow transparency protocol translation from the view of the client.

18. As to claim 7, Millet teaches the invention described in claim 6, including the address translation server further comprising:

An interface for receiving the correspondence information from the first network and sending the correspondence information to the second network (Millet, col. 11, lines 34-43). The embodiment of the address translation system on a router and several address translation lists being present inherently suggests that there are multiple translators that share their respective translation lists.

Millet does not explicitly teach the use of two differing protocols.

However, Tsirtsis teaches a process of translation of protocols (Tsirtsis, page 4, "Protocol Translation (PT)") for transferring data in a first protocol and for transferring data in a second protocol (Tsirtsis, page 4, "Protocol Translation (PT)").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millet in view of Tsirtsis in order to enable the use of two differing protocols. One would be motivated to do so in order to allow transparency protocol translation from the view of the client.

19. As to claim 8, Millet teaches the invention described in claim 7, including the address translation server where the interface sends the correspondence information to a translator connected to the second network and the third network upon receiving a query from the translator (Millet, col. 11, lines 34-43). The embodiment of the address translation system on a router and several address translation lists being present inherently suggests that there are multiple translators that share their respective translation lists.

Millet does not explicitly teach the use of two differing protocols.

However, Tsirtsis teaches a process of translation of protocols (Tsirtsis, page 4, "Protocol Translation (PT)") for transferring data in a first protocol and for transferring data in a second protocol (Tsirtsis, page 4, "Protocol Translation (PT)").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Millet in view of Tsirtsis in order to enable the use of two differing protocols. One would be motivated to do so in order to allow transparency protocol translation from the view of the client.

20. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millet in view of Tsirtsis and further in view of Vaudreuil et al. (U.S. 5,940,478).

21. As to claim 2, the combination of Millet and Tsirtsis teaches the invention described in claim 1, including upon receiving at the at least one of the other translators a packet having the first address as a destination IP address from the first terminal after a movement of the first terminal, further comprising the steps of:

Rewriting, at the at least one of the other translators, the destination IP address to the second address (Millet, col. 6, lines 53-60); and transmitting, at the at least one of the other translators, the rewritten packet to the second terminal (Tsirtsis, page 9, last paragraph).

The combination of Millet and Tsirtsis does not explicitly teach the use of multiple translators.



However, Vaudreuil teaches inquiring, at the at least one of the other translators, of the translation server about address information of the second terminal (Vaudreuil, col. 18, lines 17-22); receiving, at the at least one of the other translators, the correspondence between the first address and the second address registered by the translator from the server (Vaudreuil, col. 7, lines 42-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Millet and Tsirtsis in view of Vaudreuil in order to enable the use of multiple translators. One would be motivated to do so in order to facilitate communication between networks using differing protocols.

22. As to claim 3, the combination of Millet and Tsirtsis teaches the invention described in claim 2, including where a source IP address of the packet is rewritten to the address of the translator in the second protocol (Tsirtsis, page 12, "Source Address").

### ***Response to Arguments***

23. Applicant's arguments filed 22 April 2005 have been fully considered, but they are not persuasive for the reasons set forth below.

24. ***Applicant Argues:*** Applicant states "None of the cited prior art references teaches or suggests such 'a step of registering in a translation server connected to at least two translators the correspondence between a first address (in a first protocol) and a second address (in a second protocol) of a mobile terminal in the translation server' or such 'a translation server

which stores a correspondence information among a name of the mobile terminal, an address of the terminal in the first protocol, and an address of the terminal in the second protocol.”

*In Response:* The examiner respectfully submits that the combination of Millet and Tsirtsis teaches a step of registering in a translation server (an Internet router – see Millet, Fig. 7, element 740) connected to at least two translators (an address translation system – see Millet, Fig. 7, element 711) the correspondence between a first address and a second address (translation system maintains a translation table with one entry per node with an inside address and a corresponding outside address – see Millet, Fig. 7, element 715; col. 13, lines 26-32) of a mobile terminal (one or more of the nodes under the translation system maybe be a mobile node – see Millet, col. 6, lines 25-30) in the translation server. Routers can be connected in a hierarchical fashion, for example a router controlling a LAN being connected to a router that connects multiple LANs to the Internet, as is well known in the art. It would have been obvious to allow for the inclusion of multiple translation systems if there were three or more protocols to be connected to the Internet router, which would have a table to allow routing to and from the translation systems. Tsirtsis teaches a process of translation of protocols for transferring data in a first protocol and for transferring data in a second protocol (translation of an IPv4 packet into a semantically equivalent IPv6 packet – see Tsirtsis, page 4, “Protocol Translation (PT)”).

A translation server (an address translation system – see Millet, Fig. 7, element 711) which stores a correspondence information among a name of the mobile terminal (one or more of the nodes under the translation system maybe be a mobile node – see Millet, col. 6,

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lines 25-30), an address of the terminal in the first protocol, and an address of the terminal in the second protocol (translation system maintains a translation table with one entry per node with an inside address and a corresponding outside address – see Millet, Fig. 7, element 715; col. 13, lines 26-32). Tsirtsis teaches a process of translation of protocols for transferring data in a first protocol and for transferring data in a second protocol (translation of an IPv4 packet into a semantically equivalent IPv6 packet – see Tsirtsis, page 4, “Protocol Translation (PT)”).

25. ***Applicant Argues:*** Applicant states “The combination of references used by the Examiner merely consists of selecting bits and pieces from each reference, and then combining those bits and pieces using knowledge or hindsight gleaned from the disclosure of the present invention as a guide to support the combination.”

***In Response:*** The examiner respectfully submits that in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

26. ***Applicant Argues:*** Applicant states “Although the invention applies the general translation mechanism as disclosed in Tsirtsis, the invention applies the mechanism on mobile terminals to achieve unexpected results or properties.”

***In Response:*** The examiner respectfully submits that In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., mobile terminals) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, Millet teaches that one or more of the nodes under the translation system maybe be a mobile node (Millet, col. 6, lines 25-30).

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

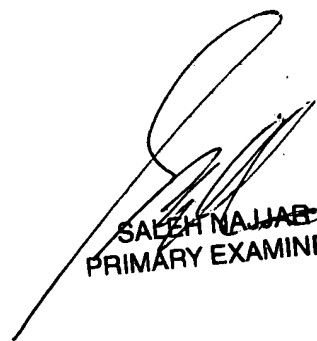
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay  
July 8, 2005



SALEH NAJJAR  
PRIMARY EXAMINER